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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/215,804	12/18/1998	MARK GAVIN	D3239-00002	1595

8933 7590 12/18/2002

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EXAMINER

BASHORE, WILLIAM L

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 12/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/215,804

Applicant(s)

GAVIN ET AL.

Examiner

William L. Bashore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 September 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6, 8-14, 16-22, 24 and 25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-14, 16-22, 24 and 25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. This action is responsive to communications: amendment filed 9/26/2002, to the original application filed 12/18/1998.
2. Claims 1-6, 8-14, 16-22, 24 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson.
3. Claims 1-6, 8-14, 16-22, 24-25 are pending. Claims 7, 15, 23 have been canceled. Claim 25 has been added. Claims 1, 5, 9, 13, 17, 21, 25 are independent claims.

#### *Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1-6, 8-14, 16-22, 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al. (hereinafter Anderson), U.S. Patent No. 5,581,682 issued December 3, 1996.**

**In regard to independent claim 1**, Anderson teaches annotation and redaction of a final-form electronic document (Anderson Abstract; compare with claim 1 preamble "*A method of redacting content from a document in electronic form, comprising the steps of*").

Anderson teaches an Image Object, a Presentation Object, an Overlay Object, and a Graphics Object, comprising geometric areas of a page, with said Overlay Object comprising an annotation (Anderson Figure 1, 3B, also column 3 lines 33-39, column 7 Table II line "Object Area Position"; compare with claim 1 "*selecting a geometric area on the document for redaction*", and "*representing said*

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*geometric area as one or more annotation objects*"). Anderson does not specifically teach said Overlay Object annotation as a source for redaction. However, this limitation would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Anderson, because Anderson teaches annotations and redactions utilizing overlays, with redaction security levels, suggesting an applied annotation which can be redacted to reflect a higher security level needed, providing the advantage of increased document security (Anderson Figure 3B, column 5 lines 3-15).

Anderson teaches identification of information representing content/location/nature of content, said information represented as objects (Anderson Figure 1, 3B, also column 6 lines 15-20; compare with claim 1 "*identifying information in the document representing content and location and nature of content*", and "*representing said identified information as one or more content objects*").

Anderson teaches a final-form document with annotated and/or redacted are present in said document, with content replaced with an opaque overlay (redaction) (Anderson Abstract, column 2 lines 25-30, column 5 lines 47-52; compare with claim 1 "*identifying content....to produce a redacted document.*").

**In regard to dependent claims 2, 3,** Anderson teaches items of information (including text) associated with an annotation object (Anderson column 6 lines 12-21; compare with claims 2, 3).

**In regard to dependent claim 4,** Anderson teaches a final-form document with annotated and/or redacted are present in said document, content replaced with an opaque overlay (redaction) (Anderson Abstract, column 2 lines 25-30, column 5 lines 47-52; compare with claim 4).

In regard to independent claim 5, Anderson teaches annotation and redaction of a final-form electronic document (Anderson Abstract; compare with claim 5 preamble “*A method of designating portions of a document for redaction, comprising the steps of*”).

Anderson teaches displaying a document (Anderson column 6 lines 3-10; compare with claim 5 “*displaying all or a portion of the document*”).

Anderson teaches an Image Object, a Presentation Object, an Overlay Object, and a Graphics Object, comprising geometric areas of a page, with said Overlay Object comprising an annotation (Anderson Figure 1, 3B, also column 3 lines 33-39, column 7 Table II line “Object Area Position”; compare with claim 5 “*designating a geographical region of the document for redaction*”). Anderson does not specifically teach said Overlay Object annotation as a source for redaction. However, this limitation would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Anderson, because Anderson teaches annotations and redactions utilizing overlays, with redaction security levels, suggesting an applied annotation which can be redacted to reflect a higher security level needed, providing the advantage of increased document security (Anderson Figure 3B, column 5 lines 3-15).

Anderson teaches identification of information representing content/location/nature of content, said information represented as objects producing a final-form document with annotated and/or redacted are present in said document (Anderson Abstract, column 2 lines 25-30, Figure 1, 3B, also column 6 lines 15-20, column 5 lines 47-52; compare with claim 5 “*saving the designations with the document*”).

The limitation of a frame with content having a geographical location within said frame, would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Anderson, because Anderson teaches a user specifying a location and orientation of annotation content within a dimensioned box on a final-form document (Anderson column 6 lines 12-20, Figure 3A-3B, 4; compare with claim 5 “*wherein the step of designating comprises manipulating a frame displayed on the document, content... visible to the user during said step of manipulation.*”), suggesting the manipulation

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and orientation (framing) of an object on a page, providing the advantage of visually orientating content objects in relation to the rest of the document.

Applying the above limitation regarding manipulation of a frame, to a redaction, would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Anderson, because Anderson teaches application of overlays to both annotations and redactions (see Anderson Figure 5). Since a document annotation can be subject to redaction, it would have been obvious to add and/or combine the redaction overlay with the annotation overlay, providing the advantage of extra security via redaction of user annotations.

**In regard to dependent claim 6**, Anderson teaches the use of descriptions and stored as offsets (Anderson columns 4 lines 12-24, columns 6-9 Tables I - III; compare with claim 6).

**In regard to dependent claim 8**, Anderson does not specifically teach batch designation. However, this limitation would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Anderson, because Anderson teaches include structures within a page, with more than one include structure per page (for each annotation/redaction) (Anderson column 3 lines 40-48). Anderson also teaches a state register set if default is for a user to view all annotations on a page (Anderson column 5 lines 28-35; compare the above with claim 8), suggesting the processing of annotations/redactions as performed in a batch manner, providing the advantage of batch (all at once) processing.

**In regard to claims 9-12**, claims 9-12 reflect the medium comprising computer executable instructions used for performing the methods as claimed in claims 1-4, and are rejected along the same rationale.

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**In regard to claims 13-14, 16,** claims 13-14, 16 reflect the medium comprising computer executable instructions used for performing the methods as claimed in claims 5-6, 8, and are rejected along the same rationale.

**In regard to claims 17-20,** claims 17-20 reflect the system comprising computer executable instructions used for performing the methods as claimed in claims 1-4, and are rejected along the same rationale.

**In regard to claims 21-22, 24,** claims 21-22, 24 reflect the system comprising computer executable instructions used for performing the methods as claimed in claims 5-6, 8, and are rejected along the same rationale.

**In regard to independent claim 25,** Anderson teaches annotation and redaction of a final-form electronic document (Anderson Abstract; compare with claim 25 preamble “*A method of designating portions of a document for redaction, comprising the steps of*”).

Anderson teaches displaying a document (Anderson column 6 lines 3-10; compare with claim 25 “*displaying all or a portion of the document*”).

Anderson teaches an Image Object, a Presentation Object, an Overlay Object, and a Graphics Object, comprising geometric areas of a page, with said Overlay Object comprising an annotation (Anderson Figure 1, 3B, also column 3 lines 33-39, column 7 Table II line “Object Area Position”; compare with claim 25 “*designating a geographical region of the document for redaction*”). Anderson does not specifically teach said Overlay Object annotation as a source for redaction. However, this limitation would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Anderson, because Anderson teaches annotations and redactions utilizing overlays, with redaction security levels, suggesting an applied annotation which can be redacted to reflect a higher security level

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needed, providing the advantage of increased document security (Anderson Figure 3B, column 5 lines 3-15).

Anderson teaches identification of information representing content/location/nature of content, said information represented as objects producing a final-form document with annotated and/or redacted are present in said document (Anderson Abstract, column 2 lines 25-30, Figure 1, 3B, also column 6 lines 15-20, column 5 lines 47-52; compare with claim 25 "*saving the designations with the document*").

The limitation regarding batch designation would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Anderson, because Anderson teaches "include" structures within a page, with more than one include structure per page (for each annotation/redaction set) (Anderson column 3 lines 40-48). Anderson also teaches a state register set if default is for a user to view all annotations on a page (Anderson column 5 lines 28-35; compare the above with claim 25 "*wherein said step of designating comprises designating all geographic regions containing content selected by a user for batch designation.*"), suggesting the processing of annotations/redactions as performed in a batch manner, providing the advantage of batch (all at once) processing.

### ***Response to Arguments***

6. Applicant's arguments filed 9/26/2002 have been fully and carefully considered but they are not persuasive.

Applicant argues on page 6 of the amendment that Anderson teaches applying redaction only if a user security level is met. Applicant also argues that (according to Anderson), either an overlay, or the content of a document, is displayed. The original document remains unchanged. The examiner notes that Anderson must keep track of security document redactions. Annotations/portions of a document must contain security marker(s), so that when a user security level is met, a match to the document marker



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occurs. Anderson's system must keep track of where said redaction is to be applied in a document. The claims do not preclude the use of overlays. In additional support of the above rejections, a redacted document presented to a user can be saved (i.e. screen dumped into a file) separately from the original (unchanged) document.

Applicant argues on page 6 of the amendment that the cited reference does not teach the limitation of claim 4. The examiner notes that an opaque overlay indicative of redaction covers up a portion of text, eliminating said text from the user, therefore, the redacted text is no longer in the document presented to a user.

Applicant argues on page 6-7 of the amendment that Anderson does not teach a displayed frame with content visible to a user within said frame. The examiner notes that Anderson teaches a user specifying a location and orientation of annotation content within a dimensioned box on a final-form document, which at least suggests a frame with user editable content.

Applicant argues on page 7 of the amendment that Anderson does not teach batch designation of content. The examiner notes that Anderson teaches "include" structures within a page, with more than one include structure per page. Anderson also teaches a state register set if default is for a user to view all annotations on a page, suggesting batch designation.

**7. Prior art made of record and not relied upon is considered pertinent to disclosure.**

Precise/Discovery, Automating the entire litigation document collection process, Website <<http://www.precise.ab.ca/products/discovery.html>>, Precise Systems Corporation, July 5, 1998 (confirmed via archive.org), downloaded on December 4, 2002, pages 1-3.

*Conclusion*

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Bashore whose telephone number is **(703) 308-5807**. The examiner can normally be reached on Monday through Friday from 11:30 AM to 8:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on **(703) 308-5186**.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is **(703) 305-3900**.

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10. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

**(703) 746-7239** (for formal communications intended for entry)

**or:**

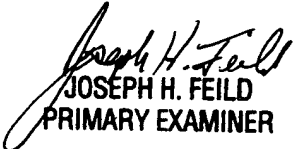
**(703) 746-7240** (for informal or draft communications, please label  
"PROPOSED" or "DRAFT")

**or:**

**(703) 746-7238** (for after-final communications)

**Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,  
Arlington, VA, Fourth Floor (Receptionist).**

William L. Bashore  
12/09/2002

  
**JOSEPH H. FEILD**  
**PRIMARY EXAMINER**